REMARKS – Summary

Applicant would respectfully like to highlight the following facts:

(a) Applicant's Specification teaches that the "`invention uses a` <u>`readily available feature of TV signals`</u>`, namely the teletext standard to transmit advertisement data to a television viewer`" (emphasis added) [Para. 0005].

(b) There are many *different and patentable*, **new and unexpected uses of teletext**, which have been embedded / inserted in a TV signal. For example, among the vast array of unobvious, *new and unexpected* ***<u>uses</u>*** of teletext data include;

- i. **Distributing Coupons** for a product advertisement (e.g. Jones et al, US Pat. 5978013);
- ii. **An Interactive TV System** between electronic devices (e.g. Yuen, US Pat. 5898919; Darbee et al, US Pat. 5978013);
- iii. **Operation of a VCR** (e.g. Yuen et al, US Pat. 7499628; Kinghorn, US Pat. 6192187);
- iv. **TV Scheduling** (e.g. Young et al, US Pat. 6167188);
- v. **TV Program Guide** (e.g. Schein et al, US Pat. 7137135 and 6151059);
- vi. **Copyright Protection Rights** (e.g. Saito, US Pat. 7447914);

vii. **Subscriber Messaging System** (e.g. Seth-Smith et al, US Pat. 4829569);

viii. **A News and Weather Distribution Service** (e.g. various European teletext systems (see Examiner's cited reference "*The Use of Electronic Media for Advertising and Selling: A Consumer Policy Outline*", Ölander and Sepstrup), etc.

Applicant's claimed invention teaches ***a new and unexpected use*** of using teletext data, i.e. by inserting/embedding an advertisement's contact information within the associated TV picture signal, and providing the TV viewer with technology to extract / store / navigate / retrieve / delete, on demand the displayed TV advertisement's contact information, so that the viewer can contact a representative of the advertisement either to inquire further about the advertisement, or to purchase the goods / services. The viewer can contact the advertisement's representative either manually or "automatically" (i.e. without having to manually re-enter the contact information on a phone or a computer, because Applicant's invention provides the means to transfer electronically the relevant contact information from a viewer's remote control device to a phone, or a computer, which then "contacts" the pertinent representative).

The Examiner's rejections are respectfully flawed for two principal reasons:

1. First and contrary to the assertion made in the rejection, there are a number of limitations found in the independent claims 1, 3, and 13, specifically:

(a) Embedding / inserting information in a television advertisement signal's associated teletext, which can be used by a viewer to contact a representative of a TV advertisement, i.e. using the embedded / inserted contact teletext data.

(b) Delineating, via tags, the television advertisement's contact teletext data so that it is easily distinguished for processing, etc.

(c) The embedding/insertion of the contact teletext data occurs in non real-time to the television advertisement's broadcast / transmission.

(d) Providing the electronics to extract the television advertisement signal's associated contact teletext data and storing it in a television receiver's circuitry for viewing / use by the recipient television viewer.

(e) Providing the means to navigate the stored contact teletext data and to select any of the contact data for use by a TV viewer.

(f) Providing the means to transfer the selected contact teletext data and to store it in the TV viewer's remote control device.

(g) Using the TV remote control's stored contact teletext data to contact a representative of the advertisement through another device such as a PC or telephone.

These above mentioned limitations (a) through (f) are ***not*** taught, ***nor*** are they suggested in the combination of **Jotikasthira**, **Jones**, **Yuen** and **Darbee**.

Therefore, a *prima facie* case of obviousness ***cannot*** be established by these relied upon four references with respect to the above limitations (a) through (f).

2. Secondly, Examiner has liberally used **hindsight**, which **is improper to determine obviousness** under 35 U.S.C.A. 103(a) [Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983) and Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988)]. All of the above mentioned limitations are in fact, *not* taught ***or*** suggested by **Jotikasthira**, **Jones**, **Yuen**, or **Darbee**. Furthermore, Examiner has made **conjectural modifications of prior art disclosures**, which are unwarranted by such disclosures and therefore are **improper** [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

Therefore, even if **Darbee**, **Jones** and **Yuen** are combined with **Jotikasthira**, the invention as defined by Applicant's independent claims would ***not*** be present through a legal modification of **Jotikasthira** and a *prima facie* case of obviousness is ***not*** established.

Any continued allegation that **Jotikasthira**, **Jones**, **Yuen** and **Darbee** can be modified so that the missing claim limitations are present is a clear use of **hindsight**, which the U.S.P.T.O. Board of Appeals has ruled against, in agreement with the courts.

That the suggestion to combine the references should ***not*** come from the Applicant was forcefully stated in Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983):

"*It is wrong to use the patent in suit as a guide through the maze of prior art references,* ***combining the right references in the right way to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law***" (emphasis added).

As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988):

"[w]*here prior-art references require selective combination by the court to render obvious a subsequent invention,* ***there must be some reason for the combination other than hindsight gleaned from the invention itself****....* ***Something in the prior art must suggest the desirability and thus the obviousness of making the combination.***" (emphasis applied).

In line with these decisions, the Board stated in Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A.&I. 1993):

> "*In order to establish a prima facie case of obviousness, it is necessary for the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention.* … ***That which is within the capabilities of one skilled in the art is not synonymous with obviousness****. … That one can reconstruct and / or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis of obviousness unless that* ***logic and reasoning also supplies sufficient impetus to have led to one of ordinary skill in the art to combine the teachings of the references to make the claimed invention*** *[…] Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a prima facie case of obviousness by some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that "would lead" that individual to "combine the relevant teachings of the references."… Accordingly* ***an examiner cannot establish obviousness by locating***

> *references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.*" (emphasis added).

Applicant respectfully submits that combining **Jotikasthira**, **Jones**, **Yuen** and **Darbee** is ***not*** legally justified and is therefore improper [In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983), Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988) and Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A.&I. 1993)]. Thus Applicant respectfully submits that the rejections on these references be withdrawn.

REMARKS – Response to Examiner's Arguments

1.0) Regarding Examiner's Response [1], Applicant notes Examiner's response.

2.0) Regarding Examiner's Response [2], Applicant, respectfully, would like to point to the Supreme Court's guidelines in the determination of obviousness under 35 U.S.C.A. 103(a) [Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545, 148 U.S.P.Q. 459, 467 (1966)], which Applicant was using in the objected to Arguments. In other words, sections (1.1) through (1.6) were **determining the scope and content of the prior art** citation of **Jotikasthira**. Sections (1.7) through (1.13) were **determining the differences between the cited prior art of Jotikasthira and the claims at issue**.

2.1) Examiner did not, with respect, read Applicant's Arguments in their entirety, but focused on sections (1.1), (1.2), (1.5) and (1.12) in order to reject the Arguments as "not persuasive" by citing In re Keller, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981) and In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

2.2) Applicant respectfully requests Examiner to reconsider Applicant's previous response in sections (1.1) through (1.13) in Applicant's previous response

(Amendment C, mailed 10/07/2008) to the Office Action postmarked August 06, 2008.

3.0) Regarding Examiner's Response [3], firstly ***nowhere*** is it taught, or suggested in **Jotikasthira** that a "`location`" can be a "mail address" as broadly interpreted by Examiner. Furthermore, a person **cannot** go to a "mail address" to purchase the products as taught in **Jotikasthira**. **Conjectural modification** of a prior art disclosure which is unwarranted by such a disclosure is **improper** [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

3.1) **Jotikasthira** teaches "`purchasing at a location`" only in [Para. 0038], and [Para. 0047].

3.1.1) **Jotikasthira** [Para. 0038] reads:

"`the user may` **`purchase`** `a particular product if the captured data is advertisement information such as a product name, price, and` **`location for purchasing`** `the product(s)…. Further, the user may` **`purchase`** `a music tape or CD of a song or songs if the captured data is the song that was broadcast including other information like the song title, artist name, and` **`location`** `for` **`purchasing`** `the tape or CD`" (emphasis added).

3.1.2) **Jotikasthira** [Para. 0047] reads:

"`a user can easily capture, send, edit, data associated with a main broadcast program (i.e. music titles, artists' names,` **`location for purchasing`** `products)`" (emphasis added).

3.2) Furthermore, there is ***no*** teaching, ***or*** suggestion of a "virtual location" as read by Examiner (page 3 of the Office Action), ***nor*** is there mention of a phone number and there is ***no*** mention of a "mail address" in **Jotikasthira**. Clearly Examiner has used Applicant's claims to read in these limitations in **Jotikasthira**. This **use of hindsight is improper** to determine obviousness under 35 U.S.C.A. 103(a) [Orthopedic Equipment Co, v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983) and Uniroyal, Inc. v.

Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988)]. Furthermore, **conjectural modification** of a prior art disclosure which is unwarranted by such a disclosure is **improper** [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

3.3) Applicant now considers Examiner's citation of **Darbee et al (Darbee)** regarding "[f]urther evidence for including contact information to contact a representative of a television advertisement". Once again using the guidelines provided by the Supreme Court in the determination of obviousness under 35 U.S.C.A. 103(a) [Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545, 148 U.S.P.Q. 459, 467 (1966)], when a person of ordinary skill in the art at the time the invention was made reads **Darbee**, it is clear that the "telephone number" mentioned by Examiner regarding **Darbee** is part of **Darbee**'s teaching of digital device communication between a "`remote control`" and "`a central computer`" [Col. 3, lines 59- 65; Col. 4, lines 5-7; Col. 6, lines 19-23] and does ***not*** teach the ability "to contact a representative of a television advertisement" as Applicant's claimed invention teaches. Clearly Examiner has used Applicant's claims to read in this limitation in **Darbee et al**. This **use of hindsight is improper** to determine obviousness under 35 U.S.C.A. 103(a) [Orthopedic Equipment Co, v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983) and Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988)]. Furthermore, **conjectural modification** of a prior art disclosure which is unwarranted by such a disclosure is **improper** [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

4.0) Regarding Examiner's Response [4], firstly Applicant would like to point out, in the context of Applicant's claims, that "`embedding`" and "`insertion`" of teletext contact data **are synonymous**, i.e. to "`insert`" teletext data into an advertisement's TV signal is synonymous with "`embedding`" the same teletext contact data in the same advertisement's TV signal. Applicant has used these two terms interchangeably in the Specification, i.e. "`embed`" see [Para. 0034], and "`insert`" see [Para. 0033]. The definitions of "`embed`" and "`insert`" in *The Merriam-Webster Dictionary*, ISBN-10 0-

87779-930-X support Applicant's interchangeable use of these synonymous words. Hence, with respect, Examiner's objections are unfounded in this context.
4.1) Secondly, regarding Examiner's claim that the "invention of Jones meet[s] this limitation as information is embedded in a television signal in the form of teletext data", clearly **Jones**, in combination with **Jotikasthira** does ***not*** teach Applicant's ***new and unexpected use*** of the television advertisement's embedded / inserted teletext data and hence is non-obvious under 35 USC 103(a).

5.0) Regarding Examiner's Response [5], Examiner states that Applicant's arguments regarding **Jones**: "the features upon which applicant relies (i.e. "updating coupon information") are not recited in the rejected claim(s)". Applicant would respectfully like to point to the fact that Examiner cited **Jotikasthira** in view of **Jones**, to which sections (2.0) through (2.17.5) are Applicant's rebuttal in accordance, as previously mentioned, with the guidelines provided by the Supreme Court in the determination of obviousness under 35 U.S.C.A. 103(a) [Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545, 148 U.S.P.Q. 459, 467 (1966)]. **Jones *only*** teaches the distribution of "`coupons`" via a television system and ***not*** an advertisement's **contact information** as Applicant's invention teaches in a ***new and unexpected use*** of teletext data. Furthermore, Examiner has clearly linked **Jones's** "coupon information" with Applicant's "`contact information`" (for example, see current Office Action, page 15, para. 2).
(5.1) Applicant was simply demonstrating that *if* **Jones** was combined with the teachings of **Jotikasthira**, as suggested by Examiner, then **the combination would be improper**, because it renders the primary reference of **Jotikasthira** inoperative for its intended purpose [Ex Parte Westphalen, 159 U.S.P.Q. (BNA) 507, 1968 WL 8191 (PTO Bd. App. 1968); Ex Parte Thompson, 184 U.S.P.Q. (BNA) 558, 559, 1974 WL 20113 (PTO Bd. App. 1974)]. Furthermore, **conjectural modification** of a prior art disclosure which is unwarranted by such a disclosure is **improper** [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].
(5.2) Applicant was arguing that incorporating **Jones** in **Jotikasthira**, i.e. substituting **Jones** "`coupons`" for **Jotikasthira** "`information data`" (Figure 1, label 18) and

using the teletext delivery method of **Jones**, would ***not*** work in the real-world of television advertising (see Applicant's previous Office Action response Amendment C, mailed 10/07/2008, section [2.15]) as Applicant's claimed invention would work.

6.0) Regarding Examiner's Response [6], firstly Examiner's statement that "teletext, like closed captioning, is a well knows [*sic*] method for encoding textual information into a video signal", Applicant clearly states in the invention's `Background` section that the "`invention` **`uses a readily available feature of TV signals`**`, namely the teletext standard to transmit advertisement data to a television viewer`" (emphasis added) [Para. 0005]. Hence, it is ***not*** simply the fact that teletext data is used by Applicant's invention, but what ***is*** important is ***how*** the teletext data is used by the invention. As clearly shown above by Applicant in the above section **REMARKS – Summary** point (b), teletext data has been used in many *new and unexpected* ways, many of which have been granted patents. Applicant's invention clearly teaches a *new and unexpected use* of teletext data in view of **Jotikasthira** and **Jones**, and hence is unobvious under 35 USC 103(a).

6.1) With respect to Examiner's claim "applicant's argument that combination of Jotikasthira and Jones is invalid, the fact that the applicant has recognized another advantage which would flow naturally from following the suggestion of prior art cannot be the basis for patentability". Firstly, it is unclear to Applicant what precisely Examiner is referring to in this statement. There is ***no*** "suggestion" in **Jotikasthira** and in **Jones** to use teletext data in the manner claimed by Applicant's invention, i.e. Applicant's invention teaches a ***new and unexpected use*** of teletext data, as is similarly (i.e. *a new and unexpected use*) taught differently in each of the above mentioned US Patents (see above in **REMARKS – Summary**, patents 5898919, 5978013, 7499628, 6192187, etc.).

6.2) If Examiner continues this objection, Applicant respectfully requests further clarification in order to respond appropriately.

7.0) Regarding Examiner's Response [7], firstly with respect to Examiner's claim that "applicant's own specification doesn't disclose this feature", i.e. that the "remote control unit can use information to communicate with a telephone [...] to contact a representative of the television advertisement", Applicant would respectfully like to draw Examiner's attention to Applicant's Specification (see Abstract; Para. 0013; Para.0069 – 0075; FIG.3 label 48). These references ***all*** discuss and / or illustrate that, for example, the "`data stored in the remote control can be used to automatically contact an advertiser for further information, or to purchase an advertised product or service. This is achieved by wirelessly transferring pertinent contact information from the remote control to various communication devices.`" [Abstract].

7.1) Secondly, Applicant would respectfully like to draw Examiner's attention to the fact the Applicant ***has*** used contacting a "Store 7" **synonymously** with contacting a "representative". For example, Applicant's Specification teaches "`using the displayed contact information to call, manually, the` ***`advertiser (e.g. the Store 7)`***" (emphasis added) [Para. 0103] and "`many advertised products do not have` **`a distributor or Store 7`**" (emphasis added) [Para. 0107].

7.2) With respect to Examiner's claim that "Yuen was used to merely point out that it would have been obvious to one of ordinary skill in the art at the time of the invention was used to modify the invention of Jotikasthira and Jones with "using a second electronic device over a network means" as disclosed by Yuen for the benefit of making it easier for a user to purchase products/service", Applicant respectfully objects to the picking out of isolated features of prior art patents to combine them in a particular way with the application of hindsight, which is required from Applicant's invention. Examiner has clearly stated that "[n]either Jotikasthira nor Jones disclose "using a second electronic device or a network means"". Furthermore, **Yuen** does ***not*** teach, ***nor*** suggest "using a second electronic device over a network means" to contact a representative of a television advertisement in the ***new and unexpected*** way that the Applicant's invention teaches. The mere fact that the prior art may be modified in the manner suggested by Examiner does ***not*** make the modification obvious unless the prior art suggested the desirability of the modification [In re Fitch, 972 F.2d 1260, 23 USPQ.2d (BNA) 1780, 1783-84 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 902, 221 USPQ (BNA) 1125, 1127 (Fed. Cir. 1984); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 886, 8 U.S.P.Q.2d (BNA) 1468, 1475 (Fed. Cir. 1988)]. ***Nowhere*** is it suggested in **Jotikasthira, Jones** or **Yuen** to use a second electronic device as claimed by Applicant's invention to contact a representative of a television advertisement.

It is clear that it would ***not*** have been "obvious to one of ordinary skill in the art at the time of the invention was used to modify the invention of Jotikasthira and Jones with "using a second electronic device over a network means" as disclosed by Yuen for the benefit of making it easier for a user to purchase products/service" and consequently the combination of these references are invalid [Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); Eversharp , Inc. v. Fisher Pen Co., 204 F. Supp. 649, 662-63, 132 USPQ (BNA) 423, 434 (N.D. Ill. 1961)]. Furthermore, **conjectural modification** of a prior art disclosure which is unwarranted by such a disclosure is **improper** [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

7.3) With respect to Examiner's claim that "[f]urther evidence for including contact information to contact a representative of a television advertisement can be found for example in Darbee et al.... Darbee discloses including a telephone number with a product advertisement", it is clear to one of ordinary skill in the art at the time the invention was made, that **Darbee** teaches the use of a "telephone number" to "send data to an autodialer modem connected to the user's phone. User responses to advertising offers can then be sent by phone **to a central computer**" (emphasis added) [Col. 3, lines 61-65] and ***not*** "to contact a representative of a television advertisement" as claimed by Applicant's invention. See also **Darbee** [Col. 6, lines 19 – 22].

Darbee, like **Yuen**, clearly teaches electronic device inter-communication using an "electronic language", i.e. DTMF, between a viewer's TV device and a central computer DTMF-enabled system. As stated in response to the previous Office Action, DTMF signaling is ***not*** a language that a representative, e.g. a person or even a web site, of a television advertisement communicates in, but is "used for telephone signaling over the line in the voice-frequency band to the call switching center. The version of DTMF used for `telephone tone dialing is known by the trademarked term Touch-Tone (canceled March 13, 1984), and is standardized by ITU-T Recommendation Q.23. Other multi-frequency systems are used for signaling internal to the telephone network."` `(See http://en.wikipedia.org/wiki/Dtmf)` [See section (3.4) of Applicant's previous Office Action response, i.e. Amendment C, mailed 10/07/2008].

REMARKS – Claim Rejections

8.0) Regarding Examiner's response [6], Applicant amended **Claim 1** to overcome this rejection.

8.1) Furthermore, Examiner states [page 7, para. 2]: "examiner acknowledges that location information can also be used to contact a representative of an advertisement". Applicant respectfully disagrees with Examiner's conclusion, because this erroneous conclusion clearly uses hindsight based on Applicant's teaching. ***Nowhere*** is it taught, ***nor*** is it suggested, in **Jotikasthira** that "location information can also be used to contact a representative of an advertisement". **Jotikasthira** does ***not*** teach anywhere that "location information" can be, for example, a telephone number, or web site to "to contact a representative of an advertisement". Examiner cites [Para. 0038] in evidence to support Examiner's above-mentioned conclusion. The pertinent section in [Para. 0038] simply teaches a "`location for purchasing the product(s)` [...] `location for purchasing the tape or CD`", which is clearly ***not*** what is claimed by Applicant's invention. Examiner's above assertion is **conjectural modification** of a prior art disclosure which is unwarranted by such a disclosure **is therefore improper** [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

8.2) Furthermore when **Jotikasthira** is read in its entirety [In re Hedges, 783 F.2d 1083, 228 U.S.P.Q. 685 (Fed. Cir. 1986)], it is clear to anyone knowledgeable in the art at the time of the invention, that **Jotikasthira** does ***not*** teach Applicant's ***new and***

unexpected use of television advertisement teletext data "to contact a representative of an advertisement".

8.3) Examiner states [page 8, para. 2] "Jotikasthira discloses advertisement data navigation instructions which would include but are not limited to "sorting" (sorting helps the user navigate the data) [data] that are sent to the television apparatus ". Applicant respectfully <u>disagrees</u> with Examiner's liberal reading of the teaching in **Jotikasthira** regarding Applicant's claimed "`television advertisement data navigation instructions`". Examiner's citation of **Jotikasthira** [Para. 0041] teaches: "<u>`sending`</u>`,` <u>`receiving`</u>`,` <u>`displaying`</u>`,` <u>`editing`</u> `and` <u>`deleting`</u> `commands` [...] <u>`sort`</u> `for sorting data in main memory, and` <u>`flush`</u> `for clearing data stored in the main memory`" (emphasis added). **Jotikasthira** [Para. 0041] does ***not*** teach *navigating* the "`data stored in the main memory`", i.e. ***moving between*** one stored datum and another stored datum as Applicant's invention teaches by using the invention's "`Standard channel input number keys 42`" and "`Channel Navigation Keys 43`" [Para. 63 - 64]. In conclusion, Examiner's above assertion that "sorting helps the user navigate the data" is <u>**conjectural modification**</u> of a prior art disclosure which is unwarranted by such a disclosure <u>**and is improper**</u> [<u>Carl Schenck, A.G. v. Norton Corp.</u>, 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

8.4) Examiner states [page 10, para. 3] that **Jones** "discloses a television apparatus where a product advertisement picture (product advertisement) is displayed and a television advertisement signal that is directly associated with the television picture (disclosed as "coupon information") is embedded using the teletext standard (see the Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention was [made] to modify the television apparatus of Jotikasthira to use the teletext standard to embed a television advertisement data signal <u>because some teletext standards facilitate a higher bit rate to other methods and commercially available teletext encoders typically include error detection and correction resulting in increased data transmission capacity and fewer errors at the receivers</u>, as disclosed by Jones (see Col. 13, lines 15-19 and lines 58-63)" (emphasis added). Applicant respectfully disagrees with this statement and conclusion by the Examiner for the following reasons:

8.4.1) Firstly, when the scope and content of **Jones** is ***fully*** understood [Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545, 148 U.S.P.Q. 459, 467 (1966)], it is clear that **Jones** does ***not*** teach, even in combination with **Jotikasthira**, Applicant's invention's *new and unexpected use* of TV advertisement teletext data. **Jones** teaches "[c]*oupon information is stored in a memory at a cable television station*. [...] *The video signal may at times,* such as during a product advertisement or other offer, *include an embedded coupon identifier*. *A coupon subsystem at the cable television station monitors each video signal and retrieves coupon information from a database when it detects a corresponding embedded coupon identifier before transmitting it*. Coupon information may be embedded using teletext standards" (emphasis added – see Abstract). Applicant's invention does ***not*** teach this methodology, i.e. using **Jones**' "data channels" [Col. 3, lines 45-55], "[c]*oupon information* [Examiner's stated similarity with Applicant's contact information] *is stored in a memory at a cable television station*" [Abstract] and a "*coupon subsystem at the cable television station monitors each video signal and retrieves coupon information from a database when it detects a corresponding embedded coupon identifier before transmitting it*" [Abstract; see also Col. 3, lines 10-43], especially when considering **Jotikasthira** in combination with **Jones**, as suggested by the Examiner. Applicant's invention does ***not*** need, ***nor*** does it teach, a "*corresponding embedded coupon identifier*" [Abstract] to embed Applicant's advertisement contact information in the TV signal whereby it "*retrieves coupon information from a database*" [Abstract]. Hence Examiner's conclusion is clearly invalid in combining **Jotikasthira** and **Jones** to reject Applicant's claim under consideration regarding 35 U.S.C. 103(a).

8.4.2) Secondly, as previously stated by Applicant in response to the previous Office Action (see Amendment C, mailed 10/07/2008, section [2.17]), Applicant respectfully continues to disagree with Examiner's **motivation** to combine **Jotikasthira** and **Jones**, i.e. "because some teletext standards facilitate a higher bit rate to other methods and commercially available teletext encoders typically include error detection and correction resulting in increased data transmission capacity and fewer errors at the receivers, as disclosed by Jones (see Col. 13, lines 15-19 and lines 58-63)" (emphasis added). Applicant's continued disagreement is based on the following reasons, which were well known in the art at the time of the invention, and which are based on sound, known **engineering facts**:

i. The Applicant does ***not*** claim the use of teletext because of (a) the "higher bit rate relative to other methods" and (b) "error detection and correction" to enable "increased data transmission capacity and fewer errors" as surmised by Examiner. Applicant's claims cover ***all*** versions of teletext standards, analog and digital, including the single VBI line standard of analog closed captioning versus, for example, the analog multi-line VBI in the WST teletext standard as cited in **Jones** [Col. 13, line19; Col. 13, lines 58-59].

ii. It is well known in the art that there "are two common methods for encoding the Teletext data into a video stream. The most common is to use the Vertical Blanking Interval or VBI. This is a generally unused space located between the vertical sync pulse and the actual `active video picture. Because of the limited number of available lines in the VBI,` **`the actual amount of data that can be transmitted is limited to about 17.76 Kbits/sec times the number of transmitted lines`**`. So, if we were to transmit 3 lines of Teletext data per field, that would work out to:`

```
One horizontal line (525) of data = 37 Bytes
or = 296 bits per line/field
     296
     × 60 (fields per second)
     17,760 bits/sec per line data rate
     × 3 lines/sec
   = 53,280 bits/sec"
```

(emphasis added) [See article titled: "*What is Teletext*", Marc Schneider, Philips Semiconductor Video Products, June 1994. For further details see http://www.action.com.tw/tech/tv/teletext-philips.pdf]

iii. Considering the lower throughput of closed captioning (i.e. only via line 21 of the analog VBI signal) for a commonly broadcast 30 second TV advertisement. This throughput is about **65 kilobytes per 30 second U.S.A. advertisement** (17,760 x 30 seconds = 532,800 bits, or 66,600 bytes [532,800 / 8 bytes]). In other words, **66,600 closed caption letters can be transmitted during an average 30 second U.S.A. television advertisement**. This allegedly, as claimed by Examiner as a motivation to combine **Jotikasthira** and **Jones**, "*low*" throughput rate of about 65 kilobytes (66,600 / 1024 kilobytes) per 30 second TV advertisement, i.e. more than 60,000 closed caption letters ***is more than sufficient data-throughput as is required in Applicant's claimed invention***. Clearly, Examiner's cited motivation (i.e. "`higher bit rate relative to other methods`"), respectfully, lacks technical substance when considering what is well known in the art. Applicant traversed a random sampling of U.S.A. displayed TV advertisements and calculated the quantity (in bytes) of typical contact information that Applicant's claimed invention would make available to a viewer (for further details, see Table 1 in Applicant's previous Office Action response, i.e. Amendment C, mailed 10/07/2008). It can be clearly seen that the quantity of required contact information is ***orders of magnitude lower***, i.e. an **average of 53 bytes** (i.e. 53 teletext characters), than that available in a system which implements the single VBI line of closed captioning during a 30 second U.S.A. television advertisement, which is the minimum throughput in any analog teletext system during a 30 second U.S.A. television advertisement. Hence Examiner's "*evidence of the motivating force which would impel one skilled in the art to do what the patent application has done*" (emphasis added) [Ex part Levengood, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter., 1993)], i.e. that it "would have been obvious to one of ordinary skill in the art at the time of the invention was to modify the television apparatus of Jotikasthira to use the teletext standard to embed a television advertisement data signal because some teletext standards facilitate a higher bit rate relative to other methods" (emphasis added) is respectfully invalid when considering the well known technical facts of teletext. In conclusion the objections under 35 U.S.C. 103 (a) respectfully should be withdrawn in consideration of **Jotikasthira** in view of **Jones**.

8.4.3) As to Examiner's motivation of "error detection and correction", this is (a) an incorrect technical assumption and (b) is a moot point when in further consideration of the legislated U.S.A. requirements for closed captioning, i.e. Title 47 CFR Part 15, which has been successfully implemented in the USA since July 1, 1993 (see Examiner's cited prior art **Yuen**, Col. 10, lines 10-23). It is a moot point ***because it is a violation of U.S.A. law to discriminate against people who have a physical handicap***, such as the hearing impaired. Thus Closed Captioning in U.S. television signals has been, and continues to be as error free as the television signal for the rest of the non-handicapped viewing population. Hence Examiner's "*evidence of the motivating force which would impel one skilled in the art to do what the patent application has done*" (emphasis added) [Ex part Levengood, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter., 1993)] is respectfully invalid and the objections under 35 U.S.C. 103(a) should be withdrawn in consideration of **Jotikasthira** in view of **Jones**.

9.0) Examiner's rejection of Claim 2 is moot because Claim 2 is a Dependent Claim.

10.0) Regarding Examiner's response [6], Applicant amended **Claim 3** to overcome this rejection.

10.1) Furthermore, please refer to Applicant's response above in sections [8.0] through [8.4.3], which apply similarly to Examiner's arguments [see page 12 para. 2; page 12 para. 4; page 14 para. 2; page 14 para. 3 and page 15 para. 2] in rejecting **Claim 3**.

11.0) Examiner's rejection of Claim 4 is moot because Claim 4 is a Dependent Claim.

12.0) Examiner's rejection of Claims 5 and 8 is moot because Claim 5 and 8 are Dependent Claims.

13.0) Examiner's rejection of Claim 7 is moot because Claim 7 is a Dependent Claim.

14.0) Claims 9 and 10 have been cancelled.

14.1) Furthermore, regarding Examiner's assertion in rejecting Claims 9 and 10, that "Jotikasthira discloses the contact information of claims 1 and 3 as being "location for purchasing the product(s)" ([0038]) (examiner understands this to be equivalent to a phone number, a web address, a mail address)" (emphasis added) is ***not*** supported anywhere in **Jotikasthira**, ***nor*** is it supported in **Jones**. This is clear **hindsight** "[t]*o embue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.*" [W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ (BNA) 303, 312-13 (Fed. Cir. 1983)]. Furthermore, **conjectural modification** of a prior art disclosure (i.e. "examiner understands this to be equivalent to a phone number, a web address, a mail address") which is unwarranted by such a disclosure is **improper** [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

15.0) Examiner's rejection of Claims 11 and 12 is moot because Claims 11 and 12 are Dependent Claims.

16.0) Regarding Examiner's response [6], Applicant amended **Claim 13** to overcome this rejection.

16.1) Furthermore please refer to Applicant's rebuttal above in sections [8.0] through [8.4.3], which similarly apply to Examiner's argument "Claim 13 is similar in scope to claim 1 and is rejected on the same basis" in rejecting **Claim 13**.

17.0) Examiner's rejection of Claim 14 is moot because Claim 14 is a Dependent Claim.

18.0) Examiner's rejection of Claim 18 is moot because Claim 18 is a Dependent Claim.

19.0) Claim 19 has been cancelled.

19.1) Furthermore, regarding Examiner's assertion in rejecting Claim 19, that "Jotikasthira discloses the contact information of claim 19 as being "location for purchasing the product(s)" ([0038]) (examiner understands this to be equivalent to a phone number, a web address, a mail address)" (emphasis added) is ***not*** supported, ***or*** suggested anywhere in **Jotikasthira**, ***nor*** is it supported, ***or*** suggested in **Jones**. This is clearly **hindsight** "[t]*o embue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.*" [W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ (BNA) 303, 312-13 (Fed. Cir. 1983)]. Furthermore, **conjectural modification** of a prior art disclosure (i.e. "examiner understands this to be equivalent to a phone number, a web address, a mail address") which is unwarranted by such a disclosure is **improper** [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

20.0) Examiner's rejection of Claim 20 is moot because Claim 20 is a Dependent Claim.

21.0) Examiner's rejection of Claim 21 is moot because (a) Claim 21 is a Dependent Claim.

22.0) Examiner's rejection of Claims 15, 16 and 17 by citing **Yuen** is moot because (a) Claims 15, 16 and 17 are Dependent Claims and furthermore (b) **Yuen** does ***not*** teach that the "remote control unit can use this information to communicate with a telephone (second electronic device) to contact a representative of the television advertisement", as claimed by Applicant.

22.1) **Yuen** teaches a "Cordless phone **back link for interactive television system**" (emphasis added) (Title; Col. 2, lines 5-60; Col. 3 line 28) "**to send selected information** from a viewer or user via the telephone connection over the public switched telephone network to a central site" (emphasis added) (Col. 3, lines 38-40), in which the "Central Site will include **a well known general purpose computer system and associated circuitry** for performing the above functions" (Col. 7, lines 38-60) (emphasis added). **Yuen** teaches that the "**DTMF tone signals are used to dial the telephone and to transmit alphanumeric data needed to complete a viewer transaction** such as the purchase of a product or a PPV television program" (emphasis added) (Col. 3, line 67 and Col. 4 lines 1-3). In summary, *nowhere* in **Yuen** is it taught that a TV advertisement's associated teletext data can be used to "contact a representative of the television advertisement" as claimed by applicant's invention, but **Yuen** *clearly* teaches contacting a central site's DTMF based computer system. Furthermore, **Yuen** clearly states that "voice reception is **not** needed" (emphasis added) (Col. 4, lines 60-61) and that **Yuen's** invention "does **not** directly interact with a user of the telephone" (emphasis added) (Col. 3, lines 54-56), as would be necessary to "contact a representative of the television advertisement" as claimed by Applicant's invention in a *new and non-obvious* way. Further support of Applicant's conclusion on **Yuen's** teaching can clearly be found in FIG. 6, blocks 308 – 320, and FIG. 7.

22.2) **Yuen** teaches a DTMF based system (commonly known as a Touch-Tone system) throughout the invention. As Applicant indicated, which is commonly known in the art at the time of the invention, in response to the previous Office Action (see Applicant's Amendment C, mailed 10/07/2008 sections [3.3] and [3.4]): "Dual-tone multi-frequency (DTMF) signaling is used for telephone signaling over the line in the voice-frequency band to the call switching center. The version of DTMF used for telephone tone dialing is known by the trademarked term Touch-Tone (canceled March 13, 1984), and is standardized by ITU-T Recommendation Q.23. Other multi-frequency systems are used for signaling internal to the telephone network." (See http://en.wikipedia.org/wiki/Dtmf). The **Yuen** invention's "television or VCR receives a television signal and extracts information related to a product or pay-per-view (PPV) event being advertised on a television program from the vertical blanking interval of the television signal. This information includes the telephone number of the central site used for making the telephone connection as well as identification information for the product or PPV event to be purchased" (Abstract) and "automatically sends dual-tone multifrequency (DTMF) tone signals representing the command over a radio frequency (RF) link to a cordless telephone base unit, which is connected to the central site by a public switched telephone network. The cordless telephone base unit initiates a telephone call to the central site and communicates the DTMF tone signals received from the DTMF circuitry in the television or VCR to the central site" (emphasis added) (Abstract). Furthermore, and **highly relevant**, **Yuen** teaches that with the "cordless telephone base unit" "voice reception is **not** needed" (emphasis added) (Col. 4, lines 60-61) and that **Yuen's** invention "does **not** directly interact with a user of the telephone" (emphasis added) (Col. 3, lines 54-56). Voice reception and interaction with "a user of the telephone" is critical in order "to contact a representative of the television advertisement", as claimed by Applicant. **Yuen** does ***not*** teach Applicant's *new and unexpected* ***use*** of a "second electronic device to contact a representative of the television advertisement".

22.3) In rejecting Claims 15, 16 and 17 based on **Jotikasthira**, **Jones** and **Yuen**, this is clearly **hindsight** "[t]*o embue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey or suggest that* *knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.*" [W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ (BNA) 303, 312-13 (Fed. Cir. 1983)]. Furthermore, **conjectural modification** of a prior art disclosure which is unwarranted by such a disclosure is **improper** [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

22.4) Hence Examiner's conclusion is invalid in combining **Jotikasthira, Jones** and **Yuen** to reject Applicant's Claims 15, 16 and 17 under 35 U.S.C. 103(a).

Conclusion

For all of the above reasons, Applicant respectfully submits that the claims are now in proper form, and that the claims all define patentability over the prior art. Therefore Applicant submits that this application is now in condition for allowance, which action is respectfully solicited.

Conditional Request For Constructive Assistance

Applicant has amended the claims of this application so that they are in proper, definite, and define novel structure, which is also unobvious. If, for any reason this application is not believed to be in full condition for allowance, Applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. §2173.02 and §707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very Respectfully

Lester Sussman

Lester Sussman
Applicant Pro Se

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I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 21313-1450" on the date below.

Date: 2009, March 27 Lester Suss Lester Sussman, Applicant